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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,273	02/19/2004	William L. Grilliot	MOR3334P0991US	4238
32116	7590	10/08/2004	EXAMINER	
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			HOEY, ALISSA L	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/782,273	<b>Applicant(s)</b> GRILLIOT ET AL.	
	<b>Examiner</b> Alissa L. Hoey	<b>Art Unit</b> 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6 and 9-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,728,970. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim a reversible garment with a high visibility side and a low visibility side.

In regard to claim 1, U.S. 6,728,970 teaches a protective garment for protecting a military or paramilitary firefighter or emergency worker. The protective garment is reversible and has a shell of high visibility and a shell of low visibility. The garment is wearable with either shell facing outwardly and the shell of high visibility has portions of reflective or fluorescent, or both which portions face outwardly when the protective garment is worn so that the shell of high visibility faces outwardly (see claim 1).

The garment of US 6,728,970 is capable of being worn in a tactical situation in which a need for low visibility overrides a need for high visibility develops or is expected to develop. The military or paramilitary firefighter or emergency worker wearing the protective garment with the shell of high visibility facing outwardly may have an opportunity to doff the protective garment, to reverse the protective garment, and to redon the protective garment with the shell of low visibility facing outwardly.

In regard to claim 2, US 6,728,970 teaches portions are provided by reflective trim affixed to the shell of high visibility (see claim 2).

In regard to claim 3, US 6,728,970 teaches when facing outwardly the shell of low visibility appears dark in ambient light (see claim 3).

In regard to claim 4, US 6,728,970 teaches when facing outwardly the shell of low visibility appears black in ambient light (see claim 4).

In regard to claim 5, US 6,728,970 teaches when facing outwardly the shell of low visibility displays camouflage (see claim 5).

In regard to claim 6, US 6,728,970 teaches the shell of low visibility does not have reflective trim or any reflective or fluorescent portion and the shells conform to national fire protection association standards for outer shells of protective garment for firefighters (claim 1).

In regard to claim 9, US 6,728,970 provides a garment for protecting a military or paramilitary firefighter or emergency worker that comprises a reversible shell of high visibility and a shell of low visibility. The garment is wearable with either shell facing outwards. The shell of high visibility has portions that are reflective, fluorescent or both,

which portions face outwardly when the protective garment is worn so that the shell of high visibility faces outwardly (claim 1).

The garment of US 6,728,970 is capable of being worn in a tactical situation in which a need for low visibility overrides a need for high visibility develops or is expected to develop. The military or paramilitary firefighter or emergency worker wearing the protective garment with the shell of high visibility facing outwardly may have an opportunity to doff the protective garment, to reverse the protective garment, and to redon the protective garment with the shell of low visibility facing outwardly.

In regard to claim 10, US 6,728,970 teaches the shell of high visibility having reflective trim affixed thereto (claim 2).

In regard to claim 11, US 6,728,970 teaches the shell of low visibility appearing dark in ambient light (claim 3).

In regard to claim 12, US 6,728,970 teaches the shell of low visibility appearing black in ambient light (claim 4).

In regard to claim 13, US 6,728,970 teaches the shell of low visibility displaying camouflage (claim 5).

In regard to claim 14, US 6,728,970 teaches the shell of low visibility does not have reflective trim or any reflective or fluorescent portion. The shell s conform to nation fire protection Association standards for outer shell of protective garments for firefighters (claim 1).

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6-8 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear in claims 6 and 14 what the Nation Fire Protection Association (NFPA) Standards are. They are not defined in the specification and they are capable of changing over time so a definition of the particular standards is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 6, 7, 8, 9, 10, 14, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldridge (US 5,933,865).

In regard to claim 1, Aldridge provides a protective garment (10) for protecting a military or paramilitary firefighter or emergency worker (column 1, lines 32-64). The protective garment (10) is capable of being reversible and has a shell of high visibility (16) and a shell of low visibility (inside of 14) depending upon what color the reverse is and what situation you are in. The garment (10) is wearable with either shell facing outwardly and the shell of high visibility has portions of reflective material (30) that faces outwardly when the protective garment is worn so that the shell of high visibility faces outwardly.

The garment of Aldridge is capable of being worn in a tactical situation in which a need for low visibility overrides a need for high visibility develops or is expected to develop. The military or paramilitary firefighter or emergency worker wearing the protective garment with the shell of high visibility facing outwardly may have an opportunity to doff the protective garment, to reverse the protective garment, and to redon the protective garment with the shell of low visibility facing outwardly.

In regard to claim 2, Aldridge teaches portions are provided by reflective trim affixed to the shell of high visibility (30).

In regard to claim 6, US Aldridge teaches the shell of low visibility does not have reflective trim or any reflective or fluorescent portions (inside of 14). The shells conform to national fire protection association standards for outer shells of protective garment for firefighters (column 1, lines 32-42).

In regard to claims 7, 8, 15 and 16, Aldridge fails to teach the shells being similar in basis weights or equal in basis weights.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided the shells being similar or equal in basis weights because Applicant has not disclosed that the shells being similar or equal in basis weights provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the shells being equal, similar or different in basis weights because as long as there is one shell of high visibility and one shell of low visibility the weight of each is not structurally critical.

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Therefore, it would have been an obvious matter of design choice to modify Aldridge to obtain the invention as specified in claims 7, 8, 15 and 16.

In regard to claim 9, Aldridge provides a garment (10) for protecting a military or paramilitary firefighter or emergency worker that comprises a shell that is capable of being reversed from a shell of high visibility (16) to a shell of low visibility (inside of 14). The garment is capable of being worn with either shell facing outwards. The shell of high visibility (16) has portions that are reflective (30) and face outwardly when the protective garment is worn so that the shell of high visibility faces outwardly.

The garment of US 6,728,970 is capable of being worn in a tactical situation in which a need for low visibility overrides a need for high visibility develops or is expected to develop. The military or paramilitary firefighter or emergency worker wearing the protective garment with the shell of high visibility facing outwardly may have an opportunity to doff the protective garment, to reverse the protective garment, and to redon the protective garment with the shell of low visibility facing outwardly.

In regard to claim 10, Aldridge teaches the shell of high visibility having reflective trim affixed thereto (30).

In regard to claim 14, Aldridge teaches the shell of low visibility does not have reflective trim or any reflective or fluorescent portion (see inside of 14). The shells conform to nation fire protection Association standards for outer shell of protective garments for firefighters (column 1, lines 32-42).

7. Claims 1, 3-5, 9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullis (US 2002/0083507).



In regard to claim 1, Mullis provides a protective garment (10) that is capable of being worn by a military or paramilitary firefighter or emergency worker. The protective garment (10) is capable of being reversible and has a shell of high visibility and a shell of low visibility depending upon what color the reverse is and what situation you are in (page 1, paragraphs 2 and 3). The garment is wearable with either shell facing outwardly and the shell of high visibility has portions of fluorescent material that faces outwardly when the protective garment is worn so that the shell of high visibility faces outwardly (page 1, paragraph 6).

The garment of Mullis is capable of being worn in a tactical situation in which a need for low visibility overrides a need for high visibility develops or is expected to develop (page 2, paragraphs 26-28). The military or paramilitary firefighter or emergency worker capable of wearing the protective garment with the shell of high visibility facing outwardly may have an opportunity to doff the protective garment, to reverse the protective garment, and to re-don the protective garment with the shell of low visibility facing outwardly (figure 6b).

In regard to claims 3, 4, 5, 11, 12 and 13, Mullis fails to teach the shell of low visibility appears dark in ambient light and the shell of low visibility appears black in ambient light. However, Mullis does teach the shell of low visibility displaying camouflage.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided the low visibility shell being dark or black in ambient light because Applicant has not disclosed that the

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low visibility shell being dark or black in ambient light provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the shell of low visibility being dark in ambient light, black in ambient light or camouflage because as long as the shell of low visibility is difficult to see in a particular situation the particular color does not effect the structure. Therefore, it would have been an obvious matter of design choice to modify Mullis to obtain the invention as specified in claims 3, 4, 11 and 12.

In regard to claim 9, Mullis provides a garment (10) capable of protecting a military or paramilitary firefighter or emergency worker that comprises a reversible shell of high visibility and a shell of low visibility (page 1, paragraphs 2 and 3). The garment is wearable with either shell facing outwards (page 2, paragraph 26). The shell of high visibility has portions that are fluorescent which face outwardly when the protective garment is worn so that the shell of high visibility faces outwardly (page 2, paragraphs 27 and 28).

The garment of Mullis is capable of being worn in a tactical situation in which a need for low visibility overrides a need for high visibility develops or is expected to develop (page 1, paragraph 17). The military or paramilitary firefighter or emergency worker wearing the protective garment with the shell of high visibility facing outwardly may have an opportunity to doff the protective garment, to reverse the protective garment, and to re-don the protective garment with the shell of low visibility facing outwardly (page 2, paragraphs 26-28).

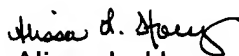
**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Girest, Hollinger, Nguyen, Blauer, Wilson, McKenney et al., Sullivan, Hauschild and Christopher are all cited to show closely related garments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (703) 308-6094. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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